

Appl. No.: 09/939,526  
Response dated July 6, 2009  
Reply to Office Action of February 4, 2009

## **REMARKS**

The Office Action of February 4, 2009 sets forth a requirement under 37 CFR § 1.105 that the Applicant identify 10-20 references of those submitted in the IDS(s) of 10/24/2002, 5/14/2003, 9/9/2003, 11/24/2003, 1/13/2005, and 3/23/2006 considered to be the most relevant by the Applicant. The Office Action further requests that for those references considered to be the most relevant by the Applicant that are in excess of 50 pages, the Applicant identify the passages considered by the Applicant to be pertinent to the instant specification and claims.

### Timeliness of This Reply

The Office Action of February 4, 2009 set a shortened statutory period of one month to reply to the Office Action. Nevertheless, Applicant respectfully submits that this response is timely filed and no fees for extension of time are needed. In this regard, the Applicant never received the Office Action of February 4, 2009 and did not become aware of the Office Action until June 2, 2009. Accordingly, Applicant filed a Petition to Reset a Period for Response Due to Late Receipt of a PTO Action (“the Petition”) on June 16, 2009. As Applicant fully anticipates the Petition being granted, Applicant does not believe that any extensions of time are necessary for filing this response. Nevertheless, should the Petition not be granted and extensions of time be deemed necessary, extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

### Impropriety of the Request Set Forth in the Office Action

Applicant respectfully submits that the Office Action sets forth a request imposing a burden on the Applicant beyond that which may be properly imposed in accordance with the MPEP. In this regard, Applicant submits that a Request for Information under 37 CFR § 1.105 as described in MPEP § 704.10, *et seq* is to aid the Examiner in “finding prior art” beyond that which the Applicant is under a duty to

Appl. No.: 09/939,526  
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provide in Information Disclosure Statements under 37 CFR § 1.56. There is no requirement imposed in the MPEP that the Applicant characterize any English language reference cited by the Applicant, nor may an Examiner require the Applicant to do so in substitute for the Examiner performing her duty to substantively examine the claims in view of the prior art available to the Examiner.

Moreover, as set forth in MPEP § 704.10:

The criteria stated in 37 CFR 1.105 for making a requirement for information is that the information be reasonably necessary to the examination or treatment of a matter in an application. The information required would typically be necessary for finding prior art or for resolving an issue arising from the results of search for art or from analysis of the application file. A requirement for information necessary for finding prior art is not a substitute for the examiner performing a search of the art according to MPEP § 704.01 and §§ 904 – 904.03. (underlining added for emphasis)

The criteria of reasonable necessity is generally met, e.g., where:

- (A) the examiner's search and preliminary analysis demonstrates that the claimed subject matter cannot be adequately searched by class or keyword among patents and typical sources of non-patent literature, or
- (B) either the application file or the lack of relevant prior art found in the examiner's search justifies asking the applicant if he or she has information that would be relevant to the patentability determination.

Applicant respectfully submits that the information requested by the Examiner is not necessary for finding prior art and does not meet the criteria of reasonable necessity as set forth by either standard (A) or standard (B), nor is any assertion made in the Office Action that either standard of reasonable necessity is met. Indeed, the request set forth in the Office Action seems to impose a duty on the Applicant to perform a search and substantive examination of the art that properly lies on the Examiner.

Further, as the Applicant has submitted all references submitted in the IDS(s) of 10/24/2002, 5/14/2003, 9/9/2003, 11/24/2003, 1/13/2005, and 3/23/2006 for consideration by the Examiner under the duty of disclosure imposed by 37 CFR § 1.56 to disclose information known “to be material to patentability.” *See*, 37 CFR § 1.56 and MPEP § 609, Applicant respectfully objects to any refusal of the Examiner to consider

Appl. No.: 09/939,526

Response dated July 6, 2009

Reply to Office Action of February 4, 2009

references submitted in the IDS(s) of 10/24/2002, 5/14/2003, 9/9/2003, 11/24/2003, 1/13/2005, and 3/23/2006 beyond those considered by the Applicant to be the most relevant.

Response to the Request Set Forth in the Office Action

Nevertheless, in the interest of obtaining a thorough examination of the claims in the instant application, the Applicant has decided to set forth references that may be of greater relevance to the claims. In this regard, the instant application is an application for reissue of U.S. Pat. No. 6,943,676 (“the ‘676 patent”). The ‘676 patent was the subject of litigation between Pumatech, Inc. (the former assignee of the instant application) and Extended Systems, Inc. in which Extended Systems, Inc. contested the validity of the ‘676 patent. The references designated AA-AN of the IDS filed 9/9/2003, which the Office Action submits “do not qualify as prior art,” include documents submitted by the parties to the litigation and include documents characterizing the claims of the ‘676 patent in view of references alleged by Extended Systems, Inc. to be prior art. Those references cited by Extended Systems, Inc. and considered in the litigation include:

U.S. Pat. No. 5,327,555 to Anderson  
U.S. Pat. No. 4,866,611 to Cree et al.  
U.S. Pat. No. 5,333,252 to Brewer et al.  
U.S. Pat. No. 5,857,201 to Wright et al.  
U.S. Pat. No. 5,926,816 to Bauer et al.  
U.S. Pat. No. 5,758,337 to Hammond  
U.S. Pat. No. 5,392,390 to Crozier  
U.S. Pat. No. 5,666,530 to Clark et al.  
U.S. Pat. No. 6,272,074 to Winner  
U.S. Pat. No. 5,813,013 to Shakib et al.  
U.S. Pat. No. 4,162,610 to Levine  
U.S. Pat. No. 5,530,853 to Schell et al.  
U.S. Pat. No. 5,278,978 to Demers et al.  
U.S. Pat. No. 5,187,787 to Skeen et al.  
U.S. Pat. No. 5,315,709 to Alston et al.  
U.S. Pat. No. 5,251,291 to Malcolm  
U.S. Pat. No. 5,706,509 to Tso  
U.S. Pat. No. 5,727,202 to Kucala  
U.S. Pat. No. 5,134,564 to Dunn et al.  
U.S. Pat. No. 4,939,689 to Davis et al.

Appl. No.: 09/939,526

Response dated July 6, 2009

Reply to Office Action of February 4, 2009

Applicant notes that the '676 patent was not found to be invalid in view of any combination of the cited references in the litigation.

Appl. No.: 09/939,526  
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## CONCLUSION

In view of the remarks presented above, it is respectfully submitted that the Applicant has fully responded to the Office Action of February 4, 2009. The Applicant respectfully submits that the claims of the present application are patentably distinct from any of the cited references, taken alone or in combination, and are in condition for immediate allowance. It is therefore respectfully requested that a Notice of Allowance be issued. The Examiner is encouraged to contact Applicants' undersigned attorney to resolve any remaining issues in order to expedite examination of the present application.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



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